



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,296	05/30/2001	Tatsushi Nashida	450100-03302	7330
20999	7590	08/10/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			SHANNON, MICHAEL R	
			ART UNIT	PAPER NUMBER

2614

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/870,296

Applicant(s)

NASHIDA ET AL.

Examiner

Michael R. Shannon

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20040913.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Chihara (USP 6,678,462), cited by Examiner.

Regarding claim 1, the claimed "recording system for recording and/or reserving a broadcast program" is met as follows:

- The claimed "means for accepting a request to record and/or reserve a broadcast program" is met by the user input device 27, which is used to input various commands [col. 5, lines 26-27], such as the request to record broadcast programs [col. 1, lines 14-21 & lines 38-40].
- The claimed "storage means for recording a broadcast program" is met by the "recording capacity" discussed in column 6, lines 15-23, which can consist of VCR 2, DVCR 3 (with data recording/reproducing unit 34), or HDD 24 [col. 5, lines 34-37].

Art Unit: 2614

- The claimed “connection means for connecting with an external device” is met by the connection from the home network 5 to the gateway and server via telephone line 12 of Figure 1 [col. 5, lines 3-5].
- The claimed “determination means for determining whether it is possible to record a broadcast program requested to be recorded and/or reserved” is met by the determination step to determine whether the selected electronic device has enough recording capacity and is functional to record the requested program [col. 6, lines 15-23].
- The claimed “means for issuing a recording substitution request to an external device via said connection means in response to a negative result of said determination” is met by the home gateway 1 being temporarily notified to store the received data on the hard disk driver 24 after the record failure handling routine executes [col. 6, lines 50-61].

Regarding claim 2, the claimed “recording system according to claim 1, wherein said determination means generates a negative result when a remaining capacity of said storage means is not sufficient for recording a broadcast program requested to be recorded and/or reserved”, is, again met by the determination step to determine whether the selected electronic device has enough recording capacity and is functional to record the requested program [col. 6, lines 15-23].

Regarding claim 3, the claimed “recording system according to claim 1, wherein said determination means generates a negative result when a failure in said system prevents a broadcast program from being recorded in said storage means” is met by the

Art Unit: 2614

determination as to whether or not it is impossible to store the requested program and the subsequent execution of the record failure handling routine [col. 6, lines 41-51].

Regarding claim 4, the claimed "recording substitution system for substitutionally recording a broadcast program" is met as follows:

- The claimed "connection means for connecting with an external device" is met by the connection from the home network 5 to the gateway and server via telephone line 12 of Figure 1 [col. 5, lines 3-5].
- The claimed "means for receiving a broadcast program" is met by the inherent reception of the broadcast programs [col. 1, lines 14-21 & lines 38-40], which can be selected and recorded by the user.
- The claimed "storage means for recording a broadcast program" is met by the "recording capacity" discussed in column 6, lines 15-23, which can consist of VCR 2, DVCR 3 (with data recording/reproducing unit 34), or HDD 24 [col. 5, lines 34-37].
- The claimed "recording substitution means for responding to reception of a recording substitution request via said connection means and receiving and recording a corresponding broadcast program in said storage means" is met by the home gateway 1 being temporarily notified to store the received data on the hard disk driver 24 after the record failure handling routine executes [col. 6, lines 50-61].

Regarding claim 5, the claimed "recording substitution system according to claim 4, wherein said recording substitution means can receive recording substitution

Art Unit: 2614

requests from a plurality of external devices and records a broadcast program corresponding to a requesting origin" is met by the fact that the home gateway 1 can act to temporarily store the requested program until a requesting electronic device becomes available [col. 6, lines 50-61].

Regarding claim 6, the claimed "recording substitution system according to claim 4 further comprising user information management means for storing user information about each requesting origin, wherein said recording substitution means records a broadcast program in a format appropriate for a user attribute of the requesting origin" is met by the discussion of the determination as to what format (analog or digital) the home gateway 1 should record and send the data to the individual user devices. Column 7, lines 4-39 describe the decision making process and the format decision according to the chosen destination device (the digital or analog VCR).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chihara (USP 6,678,462), in view of Hite (USP 5,774,170), both cited by Examiner.

Regarding claim 7, the Chihara reference teaches all of that which is discussed above with regards to claim 4. The Chihara reference, however, does not teach "the

Art Unit: 2614

recording substitution system according to claim 4 further comprising user information management means for storing user information about each requesting origin, wherein said recording substitution means for obtaining advertising information appropriate for a user attribute of the requesting origin via said connection means and inserting said information in a recorded program". While the Examiner recognized that the home gateway of the Chihara reference does contain some sort of user information management means for storing user information and determining the format for delivery and storage of content (see the claim 6 rejection), he also acknowledges the shortcomings of the Chihara reference with regards to the advertising information insertion means. Therefore, the Examiner makes note of the fact that the Hite reference teaches a Customer Database 128 that contains lists of customers and their needs and wants based on the systems and process of the invention. The data is gathered and analyzed and used for commercial message insertion and substitution [col. 10, line 54 – col. 11, line 12]. Also note that the advertisement substitution can take place at the head-end before being sent to the receiver site [col. 7, lines 52-63]. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a commercial substitution method, in order to provide commercials to consumers that match the needs and wants of the user based on prior viewing history and programming choices, especially in a VOD type system or one like Chihara, which stores programs at the head-end and provides easy means for commercial substitution.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 15, 55A. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities:

Page 11, line 8 and page 13, line 18 refer to "reproducing system 10", this should be corrected to read "receiving station 100", if the Examiner assumes correctly.

Page 12, line 16 refers to "mixer 55", however, the drawings show this part as MUX 55A.

Page 13, line 11 refers to "receiving station 10", this should be corrected to read "receiving station 100" if the Examiner assumes correctly.

Art Unit: 2614

Page 14, line 6 refers to "hard disk interface 18", this should be corrected to read "hard disk interface 16", if the Examiner assumes correctly.

Appropriate correction is required.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Franco (US Pub. No. 2002/0046407) discloses a method for remotely programming a broadcast content recording system.

Susskind (US Pub. No. 2001/0046366) discloses a system for controlling a remotely located DVR.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Shannon who can be reached at (571) 272-7356 or Michael.Shannon@uspto.gov. The examiner can normally be reached by phone Monday through Friday 8:00 AM – 5:00PM, with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at (571) 272-7353.

Any response to this action should be mailed to:

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Mail Stop _____

Art Unit: 2614

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Effective January 14, 2005, except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

United States Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Some correspondence may be submitted electronically. See the Office's Internet Web site <http://www.uspto.gov> for additional information.

Or faxed to: (571) 273-8300

Hand-delivered responses should be brought to:

Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **(571) 272-2600**.

Michael R Shannon
Examiner
Art Unit 2614

Michael R Shannon
August 5, 2005


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600